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The following abbreviations are used in this brief:

R. — Record

P. — Petition for Writ of Certiorari

P. App. — Appendices to the Petition

R. App. — Appendices to this Respondent's Brief in Opposition to the Petition

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

THE HONORABLE ERNEST GUINN, United States District Judge, VICTOR HECHT and THE HECHT VALVE COMPANY, INC., *Petitioners,* v. ACF INDUSTRIES, INCORPORATED, *Respondent.*	No. 970

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

There is nothing in this case which warrants review by this Court.

The decision of the Court of Appeals for the Fifth Circuit is manifestly correct in holding (1) that it was an abuse of discretion for Judge Guinn (United States District Judge for the Western District of Texas) to review and reverse the decision previously rendered by Judge Suttle of the same Court granting respondent's *forum non conveniens* motion, where there had been no change in circumstances and where Judge Guinn made no finding that Judge Suttle had erred in deciding that motion; and (2) that, regardless of Judge Suttle's previous decision, it was an abuse of discretion for Judge Guinn to deny respondent's *forum non conveniens* motion on its merits, where the forum had no connection with either the parties or the

facts and where the denial of that motion would permit litigation between the same parties involving the same patent to proceed in two different District Courts.

There is no conflict with any decision of this Court or with any decision in any other Circuit. There has been no departure from the accepted and usual course of judicial proceedings. No question of public importance is involved here. In short, there is no special or important reason why the writ prayed for should be granted.

OPINIONS BELOW

The opinion of the Court of Appeals for the Fifth Circuit, granting the application of respondent here for a writ of mandamus, is reported at 384 F. 2d 15 and is printed in petitioners' Appendix A.

Judge Suttle's opinion (delivered from the bench) granting respondent's *forum non conveniens* motion is printed as Appendix A to this brief.

Judge Guinn did not render any opinion in reversing Judge Suttle's decision. Judge Guinn's order is printed as Appendix B to this brief.

JURISDICTION

The jurisdictional requisites are set forth in the petition.

QUESTIONS PRESENTED

The eighteen questions presented by petitioners are based on asserted facts that are without support in the record.

For example, question 8 (P. 4) asks whether the Court of Appeals can overrule this Court's holding in *Hoffman* v.

Blaski; 363 U. S. 335 (1960), and thereby permit Judge Suttle to transfer the action below to Kansas. But the opinion of the Court of Appeals does not purport to overrule this Court. Respondent never sought, and Judge Suttle did not make, a transfer to Kansas. On the contrary, the Court of Appeals said (P. App. A-6, footnote 14):

> "Since a transfer is not requested, we need not determine if the Texas suit might have been brought in the Kansas court. See *Hoffman* v. *Blaski*, 1960, 363 U. S. 335."

The only real question presented here is whether petitioner is entitled to another hearing on the merits. But, as stated in *Magnum Co.* v. *Coty*, 262 U. S. 159, 163 (1923):

> "The jurisdiction [to bring up cases by certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

STATUTES INVOLVED

In addition to the statutes set forth in the petition*, this case involves the following statutes:

28 U. S. C. § 1651(a)—Writs

> "The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law."

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*The second statute quoted in the petition (P. 6) is 28 U. S. C. § 1338(a), not 28 U. S. C. § 1400(a) as stated in the petition.

28 U. S. C. § 2201—Creation of remedy

"In a case of actual controversy within its jurisdiction, except with respect to Federal taxes, any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such."

35 U. S. C. § 135(a)—Interferences

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office."

35 U. S. C. § 146—Civil action in case of interference

"Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. . . ."

35 U. S. C. § 281—Remedy for infringement of patent

"A patentee shall have remedy by civil action for infringement of his patent."

STATEMENT OF THE CASE

The petition before this Court concerns three cases involving a patent issued to Hecht for a carburetor valve. One case, brought by Hecht, is in the Western District of Texas against ACF and two customers for alleged infringement of the Hecht patent. A second case, pending in the District of Kansas, was brought by ACF for a declaratory judgment that the Hecht patent is invalid and not infringed. The third case, also in Kansas, is to review a decision of the United States Patent Office in an interference proceeding between Hecht and ACF. The two Kansas cases have been consolidated for trial.

Petitioner's statement is deficient in two principal respects. First, it fails to mention the facts bearing on the convenience of the parties and witnesses as to the place of

trial and, second, it fails to mention the Kansas case to review the Patent Office decision in the interference proceeding.

Facts Relevant To
Forum Non Conveniens

Victor Hecht is a resident of Kansas. The Hecht Valve Company is a Kansas corporation having its sole place of business in Kansas (P. App. A-2, footnote 3; R. 36). Neither Hecht nor The Hecht Valve Company has any connection with Texas, nor do any of their witnesses reside in Texas. All of their witnesses are residents of Kansas (R. 36-8). A pre-trial order in the two Kansas actions, listing the witnesses to be called at the trial, confirmed that all of the witnesses for Hecht were from Kansas (R. 622).

ACF Industries, a New Jersey corporation, has its principal place of business in New York, N. Y. It manufactures and sells the accused carburetors by its Carter Carburetor Division whose only plant and place of business is in St. Louis, Mo. (P. App. A-3, footnote 4; R. 37). Neither ACF nor any of its divisions manufactures any product in the Western District of Texas. Its Carter Carburetor Division does not even maintain an office in that district. None of ACF's witnesses resides in Texas (R. 37-8 and 621).

The decision to sue ACF in Texas was made by Hecht's Kansas attorneys. It was only after this decision that Texas counsel was engaged to represent Hecht (R. 254). Hecht admitted that there was no reason for bringing suit in Texas other than the fact that his trial attorneys resided in Texas (R. 297). He also testified that he would have preferred to sue ACF in Kansas because it would have been more convenient for him and his witnesses and less expensive (R. 318-9).

In holding that Judge Suttle's decision to stay the Texas action was correct, the Court of Appeals referred specifically to Judge Suttle's finding that Hecht had been "forum shopping" and that there were "no known witnesses in Texas in this case" (P. App. A-4, R. 498, 499).

Chronology of the Three Actions

This patent dispute between Hecht and ACF began in the U. S. Patent Office.

ACF filed a patent application on behalf of two employees disclosing a carburetor valve.

A few months later, Hecht filed his application which ultimately resulted in the patent in suit. This application claimed a carburetor valve similar to that shown in ACF's earlier application. If the particular Patent Office examiner in charge of Hecht's application had been aware of ACF's pending application, an interference under 35 U. S. C. § 135 would have been declared to determine the issue of priority as between the rival applicants. But the Patent Office examiner failed to discover ACF's application with the result that no interference was declared and Hecht's patent issued on September 18, 1962 (R. 828).

ACF then became aware of Hecht's claims and notified the Patent Office of its error. The Patent Office admitted its mistake in prematurely granting Hecht a patent and declared an interference. This is the subject matter of the second Kansas action. If Hecht loses the claims in the interference they will be cancelled from his patent by the force of 35 U. S. C. § 135.

On June 18, 1964, while the interference was pending, undecided in the Patent Office, Hecht filed the Texas suit alleging infringement of his patent, including the claims involved in the interference (R. 3).

Eleven days later, on June 29, 1964, ACF filed its first Kansas action against Hecht and his exclusive licensee, The Hecht Valve Company, for a declaratory judgment that the Hecht patent was invalid and not infringed (R. 10). Hecht and his valve company counterclaimed for infringement of the same claims as in the Texas action (R. 601).

ACF filed a *forum non conveniens* motion in the Texas action (R. 30) to assert:

> (1) that the Western District of Texas had no connection with either the parties or the facts of the litigation;
>
> (2) that only two judicial districts had any connection with the parties and the facts of the litigation, the District of Kansas and the Eastern District of Missouri;
>
> (3) that ACF stood ready to proceed with the litigation in either of these two convenient and logical forums; and
>
> (4) that unless Hecht came forward with a reason cognizable at law for selecting the Western District of Texas, it must be concluded that Hecht had indulged in forum shopping.

ACF sought relief under the doctrine of *forum non conveniens* by a stay of the Texas action pending final judgment in the Kansas action or, in the alternative, by a transfer of the Texas action to the Eastern District of Missouri under 28 U. S. C. § 1404(a).

The hearing before Judge Suttle extended over three days (R. 64-460). Affidavits and depositions were received in evidence and eight witnesses, including Hecht, testified. Judge Suttle granted ACF's motion and stayed the Texas action pending final judgment in the Kansas action

(R. App. A). He did not rule on a pending venue motion by ACF because his decision to stay the Texas action made such a ruling unnecessary.

On December 28, 1965, the Patent Office decided the interference, splitting the award of priority evenly—one claim to Hecht and the other to ACF.

Hecht filed a motion to vacate the stay order in the Texas case (R. 468-73 and 482). Judge Suttle denied the motion, finding that there had been no change in circumstances which would cause him to vacate his stay order (R. 492-537).

While Judge Suttle was on vacation, Hecht presented an *ex parte* motion to newly appointed Judge Guinn which sought to set aside Judge Suttle's stay order entered almost one year earlier (R. 651-62). Hecht asserted as a change in circumstances a denial by the Kansas Court of his motion to dismiss the Kansas action for lack of jurisdiction (R. 660). Judge Guinn issued an Order to Show Cause why Hecht's motion should not be granted (R. 663).

When Judge Suttle returned from vacation, he resumed his role in the Texas action and called upon ACF to file a brief in opposition to Hecht's motion to set aside the stay order (R. 664), which ACF filed on October 4, 1966 (R. 667). On October 6, 1966, Hecht sought and obtained from Judge Suttle an extension of time to answer ACF's opposing brief up to November 1, 1966 (R. 678).

On October 7, 1966, before Judge Suttle had received Hecht's answer, an order was filed in the Texas Court whereby the Civil and Criminal Dockets were divided between Judge Guinn and Judge Suttle (R. 679). The Civil Docket was assigned to Judge Guinn and the Criminal Docket was assigned to Judge Suttle. This order also contained the following provision:

> "It is provided, however, that nothing herein shall be construed as prohibiting the Judges from assisting one another with such foregoing assignment in any manner they may see fit. The disqualification of any Judge in any case assigned to him shall automatically assign such case to the one not disqualified immediately upon certification of disqualification by such Judge."

The hearing on Hecht's motion to set aside Judge Suttle's stay order was held before Judge Guinn (R. 682). No witnesses testified nor were any affidavits or depositions received in evidence at this hearing. On four separate occasions during the course of this hearing, Judge Guinn expressed his intention to have a full discussion with Judge Suttle before ruling on Hecht's motion (R. 698, 706, 716-7 and 750).

Judge Guinn entered an order which set aside Judge Suttle's stay order, overruled ACF's *forum non conveniens* motion, denied ACF's motion to dismiss for lack of venue and set the Texas action for jury* trial (R. App. B).

Judge Guinn did not file any opinion with his order or make any findings to explain the reason for his reversal of Judge Suttle's decision on ACF's *forum non conveniens* motion.

ACF asked Judge Guinn to modify his order to include the certification language of 28 U. S. C. § 1292(b) so that ACF could take an interlocutory appeal and resolve this difference of opinion between two Judges of the same Court (R: 784-9). Judge Guinn denied ACF's request (R. 795).

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*None of the parties had made a demand for a jury trial. In fact, no answer to Hecht's complaint had been filed when Judge Guinn entered his order.

ACF filed its petition for a writ of mandamus on April 3, 1967 and on September 6, 1967, the Court below granted this petition (P. App. A). On October 9, 1967, the Court below denied Hecht's petition for rehearing and for rehearing *en banc* (P. App. B).

The complications of this litigation have arisen because of a mistake by the Patent Office and two ill-conceived acts by Hecht:

1. The Patent Office made a mistake in prematurely granting Hecht a patent without first determining the issue of priority between Hecht and the two employees of ACF.

2. Hecht brought suit against ACF for infringement while the interference was still pending, knowing that the claims in interference would be cancelled from his patent by an adverse decision.

3. Hecht brought his suit against ACF in the Western District of Texas which had no connection with either the parties or the facts of the litigation.

REASONS FOR DENYING THE WRIT

The Holding Of The Court Below Is Correct

1. It Was an Abuse of Discretion to Reverse the Prior Decision of Judge Suttle

The Court below held that it was a clear abuse of discretion for Judge Guinn to review Judge Suttle's decision on ACF's *forum non conveniens* motion and to reverse that decision where there had been no change in circum-

stances* and where Judge Guinn made no finding that Judge Suttle had erred in deciding that motion (P. App. A-9).

Judge Suttle was "available" to hear and rule on Hecht's second motion to vacate his stay order. This is established not only by the saving provision of the order dividing the Civil and Criminal Dockets of that Court (*supra*, pp. 9-10), but also by Judge Guinn's repeated statement of his intention to have a full discussion with Judge Suttle before ruling on Hecht's motion to vacate the stay order (*supra*, p. 10).

Judge Guinn did not find that Judge Suttle had erred or abused his discretion in rendering his prior decision on ACF's *forum non conveniens* motion. On the contrary, Judge Guinn stated at the hearing that he recognized that there was a basis for the stay order (R. 692), but added that "I don't agree with Judge Suttle about the question of *forum non conveniens*" (R. 697). In plain terms, Judge Guinn substituted his discretion for the discretion previously exercised by Judge Suttle.

Under practically identical circumstances, the Court of Appeals for the Third Circuit in *United States* v. *Wheeler*, 256 F. 2d 745 (3 Cir. 1958), cert. denied 358 U. S. 873 (1958), held that the action of the second Judge was an abuse of discretion, observing that the rule prohibiting such action by the second Judge was "designed to prevent shop-

*In an effort to show a change in circumstances, the petition asserts (P. 37) that at the hearing before Judge Guinn, General Motors admitted that it could be liable as a manufacturer rather than as a mere customer. No such admission was made by General Motors (R. 740-1). Subsequent to the hearing and before Judge Guinn issued his order, counsel for General Motors reaffirmed the customer status of General Motors and again stated that General Motors does not manufacture a carburetor valve of the type which is the subject of the Hecht patent (R. 773-4). This was confirmed by affidavit (R. 812-6).

ping about by the defeated party for a judge more favorably disposed to whom a petition for reconsideration may be presented" (256 F. 2d at 748). There is evidence in this case of such shopping (*supra*, p. 9).

The holding in the *Wheeler* case was followed by the Court of Appeals for the Fourth Circuit in *United States* v. *Whiting*, 311 F. 2d 191, 196 (4 Cir. 1962), cert. denied 372 U. S. 935 (1963), and was applied by the Court of Appeals for the Ninth Circuit in *Johnson* v. *England*, 356 F. 2d 44, 52 (9 Cir. 1966), cert. denied 384 U. S. 961 (1966).

In *The Material Service*, 11 F. Supp. 1006 (N. D. Ill. 1934), aff'd *sub. nom. Leathem Smith-Putnam Navigation Co.* v. *Osby*, 79 F. 2d 280 (7 Cir. 1935), cert. denied 296 U. S. 653 (1935), Judge Carpenter had entered an order enjoining the plaintiffs from proceeding with suits pending in the state courts and had denied a motion for modification of his order. Subsequently another motion to modify the order was made in the case which was then before Judge Woodward of the same Court. Judge Woodward denied the motion, holding:

> "It is well settled that a judge may not overrule a prior decision of another judge of the same court in the same case. [citing cases] There has been no essential change in the record since Judge Carpenter issued the injunction and refused to modify it." (p. 1007)

All of the foregoing cases observe the general principle stated in 21 C. J. S. § 501 (p. 768):

> "Notwithstanding a few decisions to the contrary as to rulings on demurrers, it is generally considered that, in the same case, one judge may not review and overrule the prior decisions, or vacate or

> modify the prior orders, of another judge of the same court or possessing equal and coordinate power and jurisdiction, where the other judge is available at the time of the application to set aside or change his order or decision."

Two of the first statements of this principle in the Federal Courts were by Justices of this Court—Justice Miller in *Appleton* v. *Smith,* 1 Fed. Cas. 1075, No. 498, (C. C. D. Ark. 1870) and Justice Field in *Cole Silver Min. Co.* v. *Virginia & Gold Hill Water Co.,* 6 Fed. Cas. 72, 74, No. 2,990, (C. C. D. Nev. 1871).

Hecht endeavors to avoid these authorities by asserting that Judge Sutttle assigned the motion to vacate the stay order to Judge Guinn for hearing and that Judge Suttle did this because he "thought it of sufficient merit" (P. 15). From these asserted facts, Hecht argues that Judge Guinn reversed the original ruling of Judge Suttle with the consent and agreement of Judge Suttle.

The record will not support Hecht. Judge Suttle did not assign Hecht's motion to Judge Guinn for hearing but rather these two judges decided to divide the entire Civil and Criminal Dockets of their Court (*supra,* p. 9). There is nothing in the record which would indicate that Judge Suttle saw any merit in Hecht's motion. On the contrary, Judge Suttle had not received all of the briefs on this motion when the docket was divided (*supra,* p. 9). The fallaciousness of Hecht's argument is exposed by Judge Guinn's statement that "I don't agree with Judge Suttle about the question of *forum non conveniens*" (R. 697).

2. It Was an Abuse of Discretion to Deny ACF's *Forum Non Conveniens* Motion

The Court below held that, regardless of Judge Suttle's original decision, it was a clear abuse of discretion for

Judge Guinn to deny on its merits ACF's *forum non conveniens* motion (P. App. A-6 through A-9).

Prior to the enactment of 28 U. S. C. § 1404(a) in 1948, the doctrine of *forum non conveniens* usually resulted in a dismissal of the action and therefore the plaintiff's choice of forum was a dominant factor, rarely to be disturbed. *Gulf Oil Corp.* v. *Gilbert,* 330 U. S. 501, 509 (1947).

Shortly after the *Gulf Oil* case, Congress enacted the transfer statute, 28 U. S. C. § 1404(a), which permitted the application of the doctrine of *forum non conveniens* without the harsh result of dismissal. In *Norwood* v. *Kirkpatrick,* 349 U. S. 29 (1955), this Court considered the transfer statute and stated:

> "When Congress adopted § 1404(a), it intended to do more than just codify the existing law on *forum non conveniens.* As this Court said in *Ex parte Collett,* 337 U. S. 55-61, Congress, in writing § 1404(a), which was an entirely new section, was revising as well as codifying. The harshest result of the application of the old doctrine of *forum non conveniens,* dismissal of the action, was eliminated by the provision in § 1404(a) for transfer. When the harshest part of the doctrine is excised by statute, it can hardly be called mere codification. As a consequence, we believe that Congress, by the term 'for the convenience of parties and witnesses, in the interest of justice,' intended to permit courts to grant transfers upon a lesser showing of inconvenience." (p. 32)

More recently, this Court in *Van Dusen* v. *Barrack,* 376 U. S. 612, 616 (1964), stated:

> "Section 1404(a) reflects an increased desire to have federal civil suits tried in the federal system at

the place called for in the particular case by considerations of convenience and justice."

The case of *Chas. Pfizer & Co.* v. *Olin Mathieson Chemical Corp.*, 131 F. Supp. 21 (N. D. Ga. 1955), appeal dismissed 225 F. 2d 718 (5 Cir. 1955), pet. for writ of mandamus denied 225 F. 2d 720 (5 Cir. 1955), involved a situation similar to that now before this Court. In that case, the district court transferred, under 28 U. S. C. § 1404(a), a patent infringement action to another district where the defendants had filed declaratory judgment actions fourteen days after commencement of the infringement action.

There is no doubt that a district court has the power to stay an action pending the outcome of another action in another district court. *Landis* v. *North American Co.*, 299 U. S. 248, 254-5 (1936). Because a stay under the doctrine of *forum non conveniens*, like a transfer under that doctrine, avoids the harshness of a dismissal, plaintiff's choice of forum is not a dominant factor in this application of that doctrine.

Notwithstanding that the Western District of Texas had no connection with the parties, witnesses or facts of this litigation (*supra*, pp. 6-7), Judge Guinn denied ACF's *forum non conveniens* motion. Although he did not render an opinion in denying that motion, certain statements that he made during the hearing explain his subsequent order. Judge Guinn said (R. 700) "If they [Hecht] have venue there is no such thing as 'Forum Shopping'" and that, if he found venue to be proper in the Western District of Texas, he would not apply the doctrine of *forum non conveniens* by stay or by transfer (R. 697). The Court below correctly held that Judge Guinn abused his discretion in taking this position because both the doctrine of *forum non conveniens* and the transfer statute assume that venue is proper (P. App. A-7 through A-8). In *Gulf Oil Corp.* v.

Gilbert, 330 U. S. 501, 504 (1947), this Court observed that "the doctrine of *forum non conveniens* can never apply if there is absence of jurisdiction or mistake of venue." Also in *Van Dusen* v. *Barrack,* 376 U. S. 612, 634 (1964), this Court said:

> "Although both sections [28 U. S. C. §§ 1404(a) and 1406(a)] were broadly designed to allow transfer instead of dismissal, § 1406(a) provides for transfer from forums in which venue is wrongly or improperly laid, whereas, in contrast, § 1404(a) operates on the premise that the plaintiff has properly exercised his venue privilege. This distinction underlines the fact that Congress, in passing § 1404(a), was primarily concerned with the problems arising where, despite the propriety of the plaintiff's venue selection, the chosen forum was an inconvenient one."

Judge Guinn also said that he would not consider the convenience of Hecht or of Hecht's witnesses (all residents of Kansas) and that he would assume that Hecht's attorneys had a valid reason for bringing suit in Texas (R. 701, 703, 705, 712-3). This is contrary to the approach taken by this Court in the *Gulf Oil* case:

> "The plaintiff himself is not a resident of New York, nor did any event connected with the case take place there, nor does any witness, with the possible exception of experts, live there. No one connected with that side of the case save counsel for the plaintiff resides there, and he has candidly told us that he was retained by insurance companies interested presumably because of subrogation. (330 U. S. at 509)

* * *

> "Certainly to fix the place of trial at a point where litigants cannot compel personal attendance and may be forced to try their cases on deposition, is to create a condition not satisfactory to court, jury or most litigants. Nor is it necessarily cured by the statement of plaintiff's counsel that he will see to getting many of the witnesses to the trial and that some of them 'would be delighted to come to New York to testify.'" (330 U. S. at 511)

The same approach was followed in *Sypert* v. *Bendix Aviation Corporation,* 172 F. Supp. 480 (N. D. Ill. 1958), pet. for writ of mandamus denied 266 F. 2d 196 (7 Cir. 1959), cert. denied 361 U. S. 832 (1959), where the Court granted a transfer under 28 U. S. C. § 1404(a) for *forum non conveniens* (p. 486):

> "In its evaluation of 'the convenience of parties and witnesses, in the interest of justice,' the Court has not discounted the personal inconvenience to the plaintiff which trial in this forum involves. By opposing the motion, plaintiff asserts that his convenience would best be served by its denial. But an argument of this sort does not affect the plain truth that the balance of convenience to this plaintiff lies in favor of the district in which he resides."
>
> * * *
>
> "The statute speaks of the 'interest of justice' and not the sole interest of the litigant opposing the motion. The Court may not disregard the inconvenience which would accrue to plaintiff's witnesses by trial in this forum."

Even if the convenience of the parties and of the witnesses were not considered, the interest of justice would

compel the conclusion that the Texas action should have been stayed. The Court below so held, stating that "[i]n this case the stay was most appropriate, since the Kansas court was considering the Patent Office decision in the interference proceeding" (P. App. A-6) and "[i]t is obvious that Hecht's right to his patent should be decided prior to deciding if there has been an infringement of the claims in his patent" (P. App. A-6, footnote 12).

The Kansas review action is a statutory action brought under 35 U. S. C. § 146 to obtain judicial review of the Patent Office decision in the interference. It cannot be transferred to the Western District of Texas.* The Patent Office interference decision on the Hecht patent cannot be reviewed in the Texas infringement action brought under 35 U. S. C. § 281. It can only be reviewed in the Kansas review action brought under 35 U. S. C. § 146. *Deltec, Inc.* v. *Laster,* 326 F. 2d 443, 444 (6 Cir. 1964); *Pangborn Corporation* v. *American Foundry Equip. Co.,* 159 F. 2d 88, 98 (3 Cir. 1946).

A final judgment in the Kansas review action, adverse to Hecht on any claim, will automatically cancel that claim from his patent by virtue of the following provision of 35 U. S. C. § 135(a), dealing with interferences:

> "A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims in-

*Hecht filed a motion in the Kansas actions seeking to dismiss those actions for lack of jurisdiction or, in the alternative, to transfer those actions for *forum non conveniens* to the Western District of Texas (R. 796-801). The Kansas Court denied Hecht's motion to dismiss, holding that prior commencement of the infringement action in the Texas Court was not a jurisdictional bar to either of the Kansas actions (R. 821) and that the compulsory counterclaim bar does not arise until one action has proceeded to judgment (R. 822-3). The Kansas Court also denied Hecht's motion to transfer the actions to the Western District of Texas (R. 823-4).

> volved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office."

What claims will remain in the Hecht patent will not be known until final judgment has been rendered in the Kansas review action.

If the Texas action had not been stayed, it would have been necessary for both the Kansas Court and the Texas Court to consider the same patent claims, to hear the testimony of many of the same witnesses and to be "educated" in much of the same factual background and technology. In *General Tire & Rubber Company* v. *Watkins,* 373 F. 2d 361 (4 Cir. 1967), cert. denied 386 U. S. 960 (1967), the Court of Appeals issued a writ of mandamus directing the lower Court to transfer the declaratory judgment patent action brought against General Tire by Firestone to the Northern District of Ohio where General Tire's suit against U. S. Rubber for infringement of the same patent was pending. The Court of Appeals directed transfer notwithstanding that the action below in the District of Maryland had been at trial for two and one-half years, pointing to the fact that the Ohio suit against U. S. Rubber could not be transferred to the District of Maryland and stating:

> "We turn now to our reasons for issuing the writ under the extraordinary circumstances of this case. We think the district court erred in its failure to weigh the impelling need for efficiency in the administration of our court system against the right of Firestone to continue the trial in a forum which no longer offered to it any convenience over the Ohio forum. Certainly the simultaneous trial of two suits in different circuits involving a number of identical questions of fact and law would result in a useless waste of judicial time and energy. Against the judicial time and effort already spent on the Maryland

> case must be weighed the fact that the Ohio judge either has been, or will have to be, 'educated' in much of the same factual background whether or not the Ohio case against Firestone can be consolidated with its companion case against U. S. Rubber." (p. 368)

With the Texas action stayed, all the issues between Hecht and ACF, including the interference issue, will be tried by and determined by one court, the United States District Court for the District of Kansas.

Petitioners' Arguments Are Without Merit

Some of the eighteen questions presented by the petition are based on the assertion that the decision of the Court below is in conflict with the prior decisions of this Court in *Hoffman* v. *Blaski*, 363 U. S. 335 (1960) and *Kerotest Mfg. Co.* v. *C-O-Two Co.*, 342 U. S. 180 (1952), and also in conflict with the decision of the Court of Appeals for the Seventh Circuit in *Sundstrand Corporation* v. *American Brake Shoe Company*, 315 F. 2d 273 (7 Cir. 1963).

There is no conflict with *Hoffman* v. *Blaski*, because the Texas action was not transferred to the District of Kansas (*supra*, pp. 3, 8). Likewise, there is no conflict with the *Kerotest* decision because in *Kerotest* the issue of *forum non conveniens* was not before and was specifically reserved by this Court (342 U. S. at 186):

> "And if the manufacturer is joined as an unwilling defendant in a *forum non conveniens*, he has available upon an appropriate showing the relief provided by § 1404(a) of the Judicial Code."

The same reservation was made by the Court of Appeals for the Seventh Circuit in the *Sundstrand* case:

> "The Supreme Court in *Kerotest* gave its approval to the normal procedural safeguards used to

protect litigants from having to do battle in an improper forum. One of these safeguards is the application of the doctrine of *forum non conveniens* under the provision of section 1404(a) of the Judicial Code." (315 F. 2d at 275)

* * *

"Sundstrand may move to intervene in the Maryland case and then move for a *forum non conveniens* transfer to the Northern District of Illinois or the customers may make the motion on their own behalf. We are not prepared to say that that court, in such a contingency, would fail to properly exercise its discretion." (315 F. 2d at 276)

Many of the eighteen questions presented by the petition are founded upon the assertion that an action in one district court cannot be stayed pending the outcome of another action in another district court. Such an assertion is refuted by this Court's decision in *Landis* v. *North American Co.*, 299 U. S. 248, 254-5 (1936):

"Viewing the problem as one of power, and of power only, we find ourselves unable to assent to the suggestion that before proceedings in one suit may be stayed to abide the proceedings in another, the parties to the two causes must be shown to be the same and the issues identical. Indeed, counsel for the respondents, if we understand his argument aright, is at one with us in that regard, whatever may have been his attitude at the hearing in the courts below. Apart, however, from any concession, the power to stay proceedings is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants.

> How this can best be done calls for the exercise of judgment, which must weigh competing interests and maintain an even balance."

In the *Landis* case, this Court recognized the power of the District Court Judge to stay the action before him pending the outcome of an action in another district court, notwithstanding that the issues and the parties in the other action were not identical. Petitioners assert (P. 25) that the *Landis* case *"held that it had to be an emergency creating a judicial scandal before this remedy* [stay] *should be used"* (emphasis in petition). This is not correct. What this Court said in the *Landis* case (299 U. S. at 255) was that there would be occasions where it would be a scandal to the administration of justice if the courts did not have the power to coordinate their business efficiently and sensibly.

The petition, at page 36, states the general rule that the court first acquiring jurisdiction should be allowed to proceed without interference from other courts under suits subsequently instituted. But here the Kansas Court did not interfere with the proceedings in the Texas action. The decision to stay the Texas action was made by Judge Suttle of the Texas Court and by the Court of Appeals for the Fifth Circuit.

The petition also questions the availability of the writ of mandamus in the present case. In *La Buy* v. *Howes Leather Co.*, 352 U. S. 249, 257, 259-60 (1957), this Court held that the writ of mandamus was available in cases of "clear abuse of discretion" and cases where "supervisory control of the District Courts by the Courts of Appeals is necessary to proper judicial administration in the federal system." Under the principle articulated in *La Buy,* the writ of mandamus has served to afford review of extraordinary interlocutory orders. Thus, the issuance of this writ was directed in *Beacon Theatres* v. *Westover,* 359 U. S.

500 (1959), to vacate an order directing trial of certain issues to the court rather than to a jury, and in *Schlagenhauf* v. *Holder,* 379 U. S. 104 (1964), to vacate an order for medical examination of a defendant. The writ of mandamus is available to vacate orders denying *forum non conveniens* motions under § 1404(a)—*Chicago, Rock Island and Pacific Railroad Co.* v. *Igoe,* 220 F. 2d 299 (7 Cir. 1955), cert. denied 350 U. S. 822 (1955); *General Tire & Rubber Company* v. *Watkins* (*supra,* p. 20), and to review the grant or refusal of a stay—*Pet Milk Company* v. *Ritter,* 323 F. 2d 586, 588 (10 Cir. 1963).

The petition cites (P. 22-3) *Bankers Life & Cas. Co.* v. *Holland,* 346 U. S. 379 (1953), as authority for the proposition that the writ of mandamus was not available in this case. In *Bankers Life,* this Court authorized use of the writ of mandamus where "there is a clear abuse of discretion" (346 U. S. at 383), the very reason why the Court below issued the writ.

CONCLUSION

The petition should be denied.

Respectfully submitted,

WILLIAM J. BARNES,
Attorney for Respondent
FISH, RICHARDSON & NEAVE
277 Park Avenue
New York, New York 10017

Of Counsel:

JOHN O. TRAMONTINE
New York, New York

JOHN A. GRAMBLING
El Paso, Texas

January 30, 1968

APPENDIX A

District Court Opinion

Delivered From The Bench September 15, 1965

Suttle, District Judge

The Court: Well, the thing that puzzles me more than anything else as a practical matter is that we have a plaintiff here who testifies that he doesn't have the funds to litigate and I can't think of anything more fair than for him to have the privilege of litigating his law suit in his own backyard and calling on his friends and former employees to testify for him, without any expense. (R. 447)

* * *

The Court does place himself in the position of the Plaintiff and looks at it from the Plaintiff's side just as he has looked at it from the Defendant's side, and considering all the factors in evidence here, the convenience of the parties, and the witnesses, and the interest of justice, it seems to me that this Court couldn't do a greater service to the parties concerned, especially the Plaintiff, than to try his case in his own back yard, that is always the ultimate objective of nearly every litigant, to try it in a friendly atmosphere, and the Court has considered all possibilities of what the Court could do under the law, as he interprets it, and I have come to the conclusion that the injunction that this Court issued in this case No. 2657 on September 2, 1964 should be vacated as to the proceedings in the Kansas case, No. W-3222, "*ACF Industries, Inc.* vs. *Victor Hecht* and *The Hecht Valve Company, Inc.*", and that the proceedings in this case should be stayed pending the determination of the liability issue, the validity of the patent, in other words, or the issues in that Kansas case, and the Court will ask

the counsel for the defendants in this case to prepare an appropriate order setting forth that action by the Court. It does not appear to the Court that it is necessary at this time to make a ruling on the venue motions as such or order a dismissal or transfer, either one, and I believe the interests of justice will best be served by determining the Kansas case first, even though it was filed twelve days after this one was filed. (R. 452-3)

APPENDIX B

DISTRICT COURT ORDER
Entered December 16, 1966

Guinn, District Judge

ON THE 21st day of November, 1966 came on to be heard Plaintiff's Motion to Set Aside Stay Order, to Overrule Motion Filed by Defendants for Change of Venue, to Dismiss Motion Filed by Defendants for Forum Non Conveniens, and to Grant Temporary Restraining Order Restraining Defendants from Proceeding with Causes now Pending in United States District Court of Kansas;

And came the parties by their attorneys and the Court having heard the argument of counsel and considered the evidence offered in support thereof by the parties and considered the briefs of the parties, is of the opinion that the Stay Order heretofor entered in this cause on September 16, 1965 should be set aside;

It is therefore ORDERED, ADJUDGED and DECREED that said Stay Order entered on September 16, 1965 be and hereby is SET ASIDE;

It further appearing to the Court that the Court should pass upon the Defendants' Motions for Change of Venue and Forum Non Conveniens, and the Court having considered evidence submitted in regard thereto, and the argument of counsel, is of the opinion and finds that the Court has venue and further finds Defendant's Forum Non Conveniens Motion should be OVERRULED; and further finds that in the furtherance of convenience the issues of the validity of the Patent involved and the alleged infringement thereof should be tried separate and apart from the issue of damages, and that said issues should be tried in the Western District of Texas which has jurisdiction and venue of said cause of

action, and where suit was first filed and jurisdiction to determine the issues involved first acquired;

It is therefore ORDERED, ADJUDGED and DECREED by the Court that the Defendants' ACF Industries and Chrysler Corporation, Incorporated request for a change of venue be and hereby is DENIED;

And it further appearing to the Court from the evidence heretofore offered in said cause in connection with the above Motion and the statements and argument of counsel that said cause is ready for setting for jury trial on the issues of validity of patent involved and alleged infringement;

It is therefore ORDERED, ADJUDGED and DECREED that said cause be and hereby is set for jury trial at El Paso, Texas on the 1st day of May, 1967, as to the issues of validity of patent involved and alleged infringement.

It is further ORDERED that plaintiff's Petition for Temporary Restraining Order be DENIED. (R. 778-9).